

REMARKS

Please reconsider the present application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering the present application.

I. Disposition of Claims

Claims 1-21, 23, 24, 27, 29-37, and 39 are currently pending in the present application. By way of this reply, claims 17 and 23 have been amended and claims 18 and 36 have been canceled without prejudice or disclaimer.

II. Claim Amendments

Claim 17 has been amended to incorporate the limitations of now-canceled claim 18. No new matter has been added by way of this amendment.

Claim 23 has been amended to incorporate the limitations of now-canceled claim 36. No new matter has been added by way of this amendment.

III. Information Disclosure Statement

Applicant has not received an initialed PTO-1449 for the Information Disclosure Statement filed on August 19, 2002. Applicant respectfully requests consideration and return of an initialed PTO-1449 for the referenced Information Disclosure Statement.

IV. Rejection(s) Under 35 U.S.C § 103

As an initial matter, Applicant notes that various combinations of one or more of

ten references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references ranging from, for example, disclosing a TV remote control having a credit card magnetic stripe reader (U.S. Patent No. 5,870,155) to a freeway toll payment system involving a vehicle-mounted smartcard-based transponder that communicates with a toll plaza prior to the vehicle entering the toll plaza (U.S. Patent No. 6,317,721) is not appropriate. It is abundantly clearly that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a “road map” for selecting and combining prior art disclosures is wholly improper. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art”).

Claims 1, 4, 5, 10-12, 20, and 21

Claims 1, 4, 5, 10-12, 20, and 21 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,870,155 issued to Erlin (hereinafter “Erlin”) in view of U.S. Patent No. 6,317,721 issued to Hurta (hereinafter “Hurta”) and U.S. Patent No. 5,473,609 issued to Chaney (hereinafter “Chaney”). For the reasons set forth below, this rejection is respectfully traversed.

Independent claim 1 of the present application requires a receiver/decoder for use in reception of a broadcast from a remote center. The receiver/decoder includes (i) means for interacting with a user’s credit or bank card and (ii) *separate* means for interacting with a user’s smartcard, where information on the smartcard is modifiable by the remote center in response to a payment via the user’s credit or bank card.

Erlin fails to disclose at least the limitations of independent claim 1 discussed above. Erlin discloses a TV remote control (10, Figure 4) having a credit card magnetic stripe reader (92, Figure 5). A user may then make purchases with a credit card using the remote control (the remote control transmits payment information to, for example, a TV set or a TV cable remote control box). *See* Erlin, Abstract. Erlin clearly fails to disclose a receiver/decoder that has a means for interacting with a user’s credit or bank card and a *separate* means for interacting with a user’s smartcard as required by independent claim 1 of the present application.

Hurta, like Erlin discussed above, fails to disclose all the limitations of independent claim 1 or supply that which Erlin lacks. Hurta discloses a vehicle-mounted (Figure 2, 26) smartcard-based transponder (Figures 2 – 4, 14) that communicates with a freeway toll plaza (Figure 2, 29) for transaction monitoring purposes. *See* Hurta,

Abstract. However, the smartcard-based transponder in Hurta does not have a *separate* means for interacting with a user's credit or bank card. Instead, Hurta, with reference to Figure 4, expressly discloses:

The smartcard 66 may be taken by the user to a machine similar to automatic teller machines (ATM) into which money may be placed and value units representing that same amount of money or another amount of money may be placed in the smartcard 66. Alternatively, money may be debited from an account or charged to a credit account and the data representing that amount of money or another amount of money may be placed in the smartcard 66. Once this data has been placed in the smartcard 66 from the external card machine, then the user may take the smartcard with him and use it in conjunction with his transponder 14 or perhaps in other applications using compatible smartcards 66.

See Hurta, column 5, line 63 – column 6, line 8. This disclosure in Hurta of a how a user should add value to his/her smartcard effectively “teaches away” from the transponder itself having the capability to separately interact with both a user's smartcard and the user's credit or bank card. Thus, in addition to failing to disclose a receiver/decoder having *separate* means to interact with both a user's smartcard and the user's credit or bank card as required by independent claim 1 of the present application, Hurta's teaching away from the claimed invention significantly retards the ability to use Hurta in a § 103 rejection. See *In re Geisler*, 116 F.3d 1465 (Fed. Cir. 1997); MPEP 2144.05 (“A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.”) (emphasis added).

Chaney, like Erlin and Hurta discussed above, fails to disclose all the limitations of independent claim 1 of the present application or supply that which Erlin and Hurta lack. Chaney discloses a system for forming program guide information conducive to

selective display at respective receivers. *See* Chaney, column 2, lines 23 – 32. At a receiver, a subscriber specific byte stored on a smartcard is compared with a transmitted channel information byte, and dependent on that comparison, the guide data for that particular channel is either displayed or not displayed in the program guide. *See* Chaney, column 2, lines 33 – 41. However, Chaney is entirely silent as to a receiver that has (i) means for interacting with a user's credit or bank card and (ii) *separate* means for interacting with a user's smartcard as required by independent claim 1 of the present application.

In view of the above, Erlin, Hurta, and Chaney, whether considered separately or in any combination, fail to show or suggest the present invention as recited in independent claim 1 of the present application. Moreover, at least one of Erlin, Hurta, and Chaney "teach away" from the claimed invention, thereby rebutting any purported motivation or suggestion to combine these references. Thus, independent claim 1 of the present application is patentable over Erlin, Hurta, and Chaney. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 17 and 19

Claims 17 and 19 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Hurta, Chaney, and U.S. Patent No. 5,748,908 issued to Yu (hereinafter "Yu"). For the reasons set forth below, this rejection is respectfully traversed.

Independent claim 17 requires, at a receiver/decoder at which information

concerning an item or service is received, (i) reading credit or bank card information, (ii) generating an order request identifying the item or service and the credit or bank card information, (iii) verifying a remote center, and (iv) following verification, transmitting the order request to the remote center for processing. Verifying the remote center involves (i) inputting a random number by a user, (ii) passing the random number to the remote center, (iii) receiving the random number in an encrypted form from the remote center, and (iv) decrypting the encrypted random number to verify the remote centre.

As stated in the instant Office Action, Erlin, Hurta, Chaney fail to disclose the step of verifying a remote center as required by amended independent claim 17 of the present application. *See* Office Action of November 5, 2004, page 6. Yu, which is relied upon as disclosing the verifying step of independent claim 17, fails to disclose a protocol in which a user supplies a random number to a remote center and then verifies the remote center through decrypting a remote center encryption of the random number. Yu simply discloses that a merchant uses a dial-up asynchronous or synchronous modem to establish a data communications link among the merchant, the credit/debit card issuer, and the data cards system controller. *See* Yu, column 13, lines 1 – 5; Figure 4. Yu is entirely silent as to the verifying steps recited in amended independent claim 17 of the present application.

In view of the above, Erlin, Hurta, Chaney, and Yu, whether considered separately or in any combination, fail to show or suggest the present invention as recited in independent claim 17 of the present application. Thus, independent claim 17 of the present application is patentable over Erlin, Hurta, Chaney, and Yu. Dependent claim 19 is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 23, 33, 37, and 39

Claims 23, 33, 37, and 39 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of U.S. Patent No. 5,351,296 issued to Sullivan (hereinafter "Sullivan"). For the reasons set forth below, this rejection is respectfully traversed.

Amended independent claim 23 of the present application requires, in part, that the item of equipment include (i) means for interacting with a user's credit or bank card, and (ii) means, *separate* from said interacting means, for interacting with a user's smartcard.

As discussed above, Erlin clearly fails to disclose means for interacting with a user's credit or bank card and a *separate* means for interacting with a user's smartcard. Sullivan, like Erlin, fails to disclose these limitations. Sullivan, which discloses a method and device for determining and securely transmitting an account code of a financial card over a communications link in a communications network to a remote location which also allows a telephone to be used concurrently to perform voice communications over the same communications link with the remote location (*see* Sullivan, Abstract), is entirely silent as to any device having (i) means for interacting with a user's credit or bank card and (ii) *separate* means for interacting with a user's smartcard as required by amended independent claim 23 of the present application.

In view of the above, Erlin and Sullivan, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claim 23 of the present application. Thus, amended independent claim 23 of

the present application is patentable over Erlin and Sullivan. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 36

Claim 36 of the present application was rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Sullivan and Hurta. For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Erlin, Sullivan, and Hurta fail to disclose a device having (i) means for interacting with a user's credit or bank card and (ii) *separate* means for interacting with a user's smartcard as required by amended independent claim 23 of the present application. Thus, amended independent claim 23 of the present application is patentable over Erlin, Sullivan, and Hurta. Dependent claim 36 is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 13 and 14

Claims 13 and 14 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin. For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Erlin fails to disclose all the limitations of independent claim 1 of the present application. Thus, independent claim 1 is patentable over Erlin, and dependent claims 13 and 14 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2, 3, 15, and 16

Claims 2, 3, 15, and 16 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Chaney and U.S. Patent No. 5,491,827 issued to Holtey (hereinafter “Holtey”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, independent claim 1 of the present application requires, in part, that a receiver/decoder include (i) means for interacting with a user’s credit or bank card, and (ii) *separate means* for interacting with a user’s smartcard. Further, as discussed above, Erlin and Chaney fail at least to disclose these limitations of independent claim 1 of the present application. Holtey, like Erlin and Chaney, also fails to disclose at least these limitations. Holtey discloses a system in which a secure memory card can be operatively connected to communicate with a host microprocessor. *See* Holtey, Abstract; Figure 1. Holtey is entirely silent as to any device that has (i) means for interacting with a user’s credit or bank card and (ii) *separate means* for interacting with a user’s smartcard as required by independent claim 1 of the present application. Thus, Holtey fails to disclose or teach at least those limitations of independent claim 1 not disclosed by Erlin and Chaney.

Independent claim 15 of the present application requires, in part, that a receiver/decoder have (i) means to accommodate a credit or bank card carrying a microprocessor, and (ii) means to accommodate a smartcard. As discussed above, Erlin, Chaney, and Holtey fail to disclose these limitations.

In view of the above, Erlin, Chaney, and Holtey, whether considered separately or

in any combination, fail to show or suggest the present invention as recited in independent claims 1 and 15 of the present application. Thus, independent claims 1 and 115 of the present application are patentable over Erlin, Chaney, and Holtey. Dependent claims 2, 3, and 16 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 6-9

Claims 6-9 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Chaney and U.S. Patent No. 5,603,078 issued to Henderson (hereinafter "Henderson"). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Erlin and Chaney fail to disclose all the limitations of independent claim 1 of the present application. Like Erlin and Chaney, Henderson fails to disclose all the limitations of independent claim 1 or supply that which Erlin and Chaney lack. Henderson discloses an infrared remote control unit having an integrated card reading device so as to allow for the purchasing of products or services offered via a television monitor. *See* Henderson, Abstract; Figure 1. However, Henderson is entirely silent as to any device that has (i) means for interacting with a user's credit or bank card and (ii) *separate means* for interacting with a user's smartcard as required by independent claim 1 of the present application. Thus, Henderson fails to disclose or teach at least those limitations of independent claim 1 not disclosed by Erlin and Chaney.

In view of the above, Erlin, Chaney, and Henderson, whether considered separately or in any combination, fail to show or suggest the present invention as recited

in independent claim 1 of the present application. Thus, independent claim 1 of the present application is patentable over Erlin, Chaney, and Henderson. Dependent claims 6-9 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 18 and 27

Claims 18 and 27 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Chaney, U.S. Patent No. 5,475,756 issued to Merritt (hereinafter “Merritt”), and U.S. Patent No. 5,787,154 issued to Hazra (hereinafter “Hazra”). For the reasons set forth below, this rejection is respectfully traversed.

Although claim 18 has been canceled by way of this reply, the limitations of claim 18 now appear in amended independent claim 17 of the present application. As discussed above, Erlin and Chaney fail to disclose all the limitations of amended independent claim 17 of the present application. Like Erlin and Chaney, Merritt and Hazra fail to disclose all the limitations of amended independent claim 17 or that which Erlin and Chaney lack.

As stated in the instant Office Action, Merritt discloses “an ATM system which utilizes a random number generator to encrypt random numbers which are passed back and forth between an ATM machine and a central bank.” *See* Office Action of November 5, 2004, page 13 (citing Merritt, column 5, line 18 – column 6, line 20). However, amended independent claim 17 of the present application requires that the remote center encrypt the random number, not the terminal that sends the random number (e.g., the

ATM machine in Merritt). Thus, Merritt clearly fails to disclose the verifying protocol recited in amended independent claim 17 of the present application.

Hazra is further relied on as disclosing “a smart card like authentication device ... in which a user may ... enter a PIN or a random number ... the device then communicates with a telephone to authenticate the user.” *See* Office Action of November 5, 2004, page 13 (citing Hazra, column 2, line 31 – column 3, line 49). In Hazra, it is clear that authentication occurs by sending encrypted audio signals from a user (e.g., telephone) over a communication path to an authentication mechanism located in the telephone network. *See* Hazra, Abstract; Figure 1. The telephone performs the encryption, *not* the authentication mechanism. Moreover, in Hazra, the user is being verified, not an entity in communication with the user. In contrast, amended independent claim 17 of the present application requires verifying the remote center by a process involving encrypting a random number at the remote center. Thus, Hazra clearly fails to disclose the verifying protocol recited in amended independent claim 17 of the present application.

With respect to amended independent claim 23 of the present application, like Erlin discussed above, Chaney, Merritt, and Hazra fail at least to disclose a device having (i) means for interacting with a user’s credit or bank card and (ii) *separate* means for interacting with a user’s smartcard.

In view of the above, Erlin, Chaney, Merritt, and Hazra, whether considered separately or in any combination, fail to show or suggest the present invention as recited in independent claims 17 and 23 of the present application. Thus, independent claims 17 and 23 of the present application are patentable over Erlin, Chaney, Merritt, and Hazra.

Dependent claim 27 is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 30-32, 34, and 35

Claims 30-32, 34, and 35 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlin in view of Chaney, Merritt, Hazra, and U.S. Patent No. 5,644,354 issued to Thompson (hereinafter "Thompson"). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Erlin, Chaney, Merritt, and Hazra fails to disclose all the limitations of amended independent claim 23 of the present application. Similarly, Thompson fails to disclose all the limitations of amended independent claim 23 or supply that which Erlin, Chaney, Merritt, and Hazra lack. Thompson, which discloses an interactive video information retrieval system enabling a viewer to access continually updated information resources (*see* Thompson, column 1, lines 4 – 9), is completely silent as to any device having (i) means for interacting with a user's credit or bank card and (ii) *separate* means for interacting with a user's smartcard as required by amended independent claim 23 of the present application. Thus, Thompson fails to disclose or teach at least those limitations of amended independent claim 23 not disclosed by Erlin, Chaney, Merritt, and Hazra.

In view of the above, Erlin, Chaney, Merritt, Hazra, and Thompson, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claim 23 of the present application. Thus, amended independent claim 23 of the present application is patentable over Erlin, Chaney, Merritt,

Hazra, and Thompson. Dependent claims are allowable for at least the same reasons.
Accordingly, withdrawal of this rejection is respectfully requested.

V. Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places the present application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345.102001).

Date: _____

3/7/05

Respectfully submitted,

W. Kussner REG. NO. 51,048
FOR _____

Jonathan P. Osha, Reg. No. 33,986
OSHA & MAY L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778

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